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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,014	10/16/2003	David Duncan	06318.00001	7409

22908 7590 07/18/2005

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CHICAGO, IL 60606

EXAMINER
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GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,014

Applicant(s)

DUNCAN, DAVID

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-8, in the reply filed on March 14, 2005 is acknowledged.

***Response to Amendment***

The rejection of claim 8 under 35 U.S.C. 112, second paragraph is moot in view of applicant's amendment.

The rejection of claims 1 and 6 under 35 U.S.C. 102(b) as being anticipated by Olson et al, 3,528,852 is withdrawn in view of applicant's arguments.

The rejection of claims 1 and 6-7 under 35 U.S.C. 102(b) as being anticipated by Hiraoka et al, 3,906,139 or McCarthy, 4,330,956 is withdrawn in view of applicant's arguments.

The objection of claims 2 and 4-5 is withdrawn upon further consideration and in view of newly cited prior art.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bower 2,767,113 in view of MacMurry 3,290,854.

Bower teaches wire ties comprising a coating adhered to a surface of a metal wire, wherein the coating comprises a first and second plastic resin, per claim 1. The plastic resin is polyvinyl chloride and a lacquer of polyvinyl chloride, per claim 2. It is the position of the examiner that the polyvinyl chloride plastic and lacquer of polyvinyl chloride comprising ethyl alcohol would have different molecular weights. See column 1, line 70 through column 2 and line 13. Applicants should note that the language of "comprising a first and second plastic resin" does not exclude layers. Bower does not teach that his coating is textured. MacMurry teaches wire ties comprising plastic covered wire having greatly improved holding power, per claim 8, said wire ties having serrations or slits or notches in the plastic coating and wherein the plastic can be polyvinyl chloride. See column 1, line 10 and lines 68-71 and column 2, lines 17-25 and line 51. It would have been obvious to the skilled artisan to modify the wire tie taught by Bower by including serrations in the plastic coating to improve the holding power of the tie. As to claim 6, MacMurry teaches that the plastic coating has a thickness within applicant's range. See column 2, line 58. Also, with respect to claims 6 and 7, limitations with respect to the thickness of the coating and wire diameter are drawn to the size, wherein changes in size are ordinarily not a matter of invention. Alternatively, plastic coating thicknesses in the range contemplated by applicant are well known in the art as evidenced by the teachings of MacMurry. It would have been an obvious expedient to modify the teachings of Bower by forming a wire tie having a plastic coating thickness known in the art motivated by the teachings of MacMurry. Regarding claim 3, the prior art clearly provides direction to the skilled artisan as to what plastics

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are suitable, e.g. polyvinyl chloride, and a suggestion as to a reasonable expectation of success in forming a wire tie using polyvinyl chloride resin. Hence, the specific polyvinyl chloride is not construed to be a matter of invention in the absence of factual evidence of record of patentably distinguishable properties directly related to the specific polyvinyl chloride resin used. As to claims 4 and 5, Bower teaches a wire tie comprising first and second resin coatings, as does applicant, wherein these resins are polyvinyl chloride, as contemplated by applicant. Accordingly, it is the examiner's position that since the results sought and the ingredients used were known, it was well within the expected skills of one having ordinary skill in this art to arrive at the optimum proportions of those ingredients. Moreover, there is no clear evidence on this record of improved or unexpected properties of the instant claimed wire tie, said properties being directly related to the specific polyvinyl chlorides used and the proportions of each.

Therefore, the combined teachings of Bower and MacMurry would have rendered obvious the invention as claimed in present claims 1-8.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

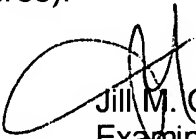
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jill M. Gray  
Examiner  
Art Unit 1774

jmg